

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:  
K. Kuhlman

Serial No.: 10/629,015

Filed: July 29, 2003

For: A METHOD OF SAMPLE  
PREPARATION FOR ATOM PROBES  
AND SOURCE OF SPECIMENS



Examiner: K. Ngyugen  
Group Art Unit: 2881

**REQUEST FOR REFUSAL**

**TO ACCEPT A CLEARLY ERRONEOUS EXPRESS ABANDONMENT**

Hon. Commissioner of Patents and Trademarks  
Washington DC 20231

Sir:

The Applicant received a Notice of Allowance in the present application on May 5, 2004. The Base Issue Fee was paid on June 30, 2004. On July 16, 2004 applicant filed a continuation application and inadvertently used the CPA form with express abandonment as part of the form boilerplate. What was intended was to file a continuation under 37 CFR 1.53b.

Under MPEP 711.01 after a Notice of Allowance is issued an express abandonment must be accompanied by a Petition to Withdraw the application from issue under 37 CFR 1.313. No such Petition to Withdraw was filed nor were any petition fees tendered. Under 37 CFR 1.313 the approval of the Director of the USPTO is required in order to allow a Petition to Withdraw and payment of

the fee under 37 CFR 1.17h. No such approval was granted and no such fee was paid or tendered.<sup>1</sup>

While withdrawal after payment of the Base Issue is permitted for a continued application, it must be executed through petition, which was not done in the present application and the inadvertent express abandonment should have been refused.

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<sup>1</sup> § 1.313 Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For interference.

(c) *Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:*

(1) Unpatentability of one or more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

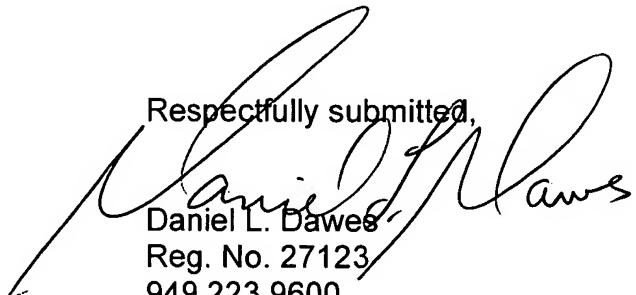
(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application

The Office should issue a letter refusing abandonment under the CPA for the foregoing failures to comply with the regulations regarding withdrawal after Notice of Allowance and payment of the Base Issue Fee; and should assign a continuation serial number under 37 CFR 1.53b to the continued application.

Applicant requests issuance of the parent application and assignment of a new serial number to the continuation application.

Respectfully submitted,

  
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**TRANSMITTAL LETTER**  
**(General - Patent Pending)**

Docket No.  
CIT.PAU.39

In Re Application Of: K. Kuhlman

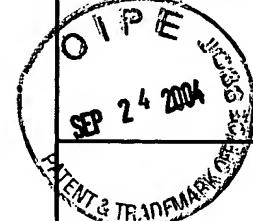
Serial No.  
10/629,015

Filing Date  
July 29, 2003

Examiner  
K. Ngyugen

Group Art Unit  
2881

Title: A Method of Sample Preparation for Atom Probes and Source of Specimens



TO THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE:

Transmitted herewith is:

**REQUEST FOR REFUSAL TO ACCEPT A CLEARLY ERRONEOUS EXPRESS ABANDONMENT  
RETURN RECEIPT POSTCARD**

in the above identified application.

No additional fee is required.

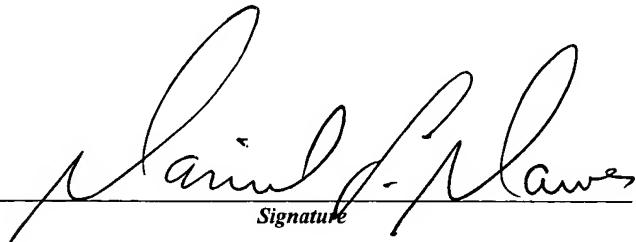
A check in the amount of \_\_\_\_\_ is attached.

The Director is hereby authorized to charge and credit Deposit Account No. 01-1960  
as described below.

Charge the amount of \_\_\_\_\_

Credit any overpayment.

Charge any additional fee required.

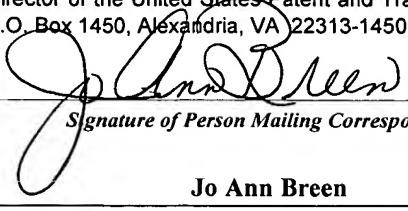


Signature

Dated: September 21, 2004

Daniel L. Dawes, Registration No. 27,123  
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Irvine, California 92612

I certify that this document and fee is being deposited  
on 9/21/2004 with the U.S. Postal Service as  
first class mail under 37 C.F.R. 1.8 and is addressed to the  
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P.O. Box 1450, Alexandria, VA 22313-1450.

  
Signature of Person Mailing Correspondence

Jo Ann Breen

Typed or Printed Name of Person Mailing Correspondence

cc: